REMARKS

In the Final Office Action, the Examiner rejected claims 1-2, 4-7, 10-11, 15, and 16

under 35 U.S.C. § 102(b) as being anticipated by Tateishi (U.S. Patent No. 5,669,007)[1];

and rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Tateishi in view

of Bello et al. (U.S. Patent No. 6, 496, 819). Based on the following reasoning, Applicants

respectfully traverse the Examiner's rejections under 35 U.S.C. § 102 and § 103(a).

I.   The Rejection of Claims 1-2, 4-7, 10-11, and 15-16 Under 35 U.S.C. § 102(b).

Claims 1-2, 4-7, 10-11, and 15-16 were rejected under 35 U.S.C. § 102(b) as being

anticipated by Tateishi. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102(b), each and every element as

set forth in the claims must be found, either expressly or inherently described, in a single

prior art reference. M.P.E.P. § 2131. Tateishi fails to teach each and every recitation of

claims 1—2, 4-7, 10-11, and 15-16. In particular, Tateishi at least fails to teach "[a]

structured document search method for searching a structured document database"

including, *inter alia*, "generating a search plan . . . in which a search processing procedure

for said structured document database is developed," as recited in claim 1.

Tateishi is directed toward a system whereby a paper document is scanned and

matched with predetermined patterns on a line-by-line basis. Abstract and col. 6, lines 45-

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[1] Although the Examiner rejected claims 1-2, 4-7, 10-11, and 15-16 under 35 U.S.C. § 102(e), Applicants note that Tateishi issued on September 16, 1997, which is more than one year prior to the Applicants' filing date of November 17, 2000. Accordingly, Applicants assume that the Examiner intended to reject these claims under 35 U.S.C. § 102(b) instead.

52. Such scanning and matching of predetermined patterns of a paper document do not constitute a search of a "structured document database," as recited in claim 1.

The Examiner alleges that "Tateishi teaches 'A structured document search method for searching a structured document database . . .," citing Col. 6, lines 27-59, Col. 17, line 64-Col. 18, line 50 and Fig. 4. OA at 2. According to Tateishi, however, dictionary 416 "describes the correspondence between character strings . . . which can be the keywords of the logical structure of a document and combinations of attributes representing the logical structure." Col. 8, lines 51-56. Thus, Tateishi teaches that dictionary 416 can store key words of a document, but does not teach storing documents themselves. Accordingly, dictionary 416 does not correspond to the claimed structured document database, and Tateishi necessarily fails to teach the claimed "structured document search method for searching a structured document database," as recited in claim 1.

Applicants also note that, the Examiner asserts that col. 6, lines 27-59, col. 12, line 43-col. 13, line 5, and col. 17, line 64-col. 18, line 50 of Tateishi teach "analyzing the accepted search request to generate a search graph including graph nodes based on the logical structure, wherein a variable to be embodied is inserted between the graph nodes," as recited in claim 1. OA at 3. The only portion of these cited teachings, however, that relates to nodes s found at Col. 18, lines 17-21, which describes that "data representing a path starting from the start and reaching the end is ordered and expressed in an ascending order of the costs associated with the nodes land links on the path." (emphasis added.) Applicants submit that such teachings in the reference do not correspond to the claimed graph nodes.

Tateishi teaches that "[t]o order the possible interpretations according to their plausibility, a document is represented in the graph creating section by a directed graph whose nodes are the respective ones of attributes of each line and whose links are the adjacency of lines." *See* Tateishi, col. 12, lines 35-42. Thus, although Tateishi discloses graph nodes at col. 12, the reference is silent as to variables inserted between such nodes. Accordingly, Tateishi fails to teach the claimed "variable to be embodied that is inserted between the graph nodes," as recited in claim 1. Therefore, Tateishi certainly fails to teach "analyzing the accepted search request to generate a search graph including graph nodes based on the logical structure, wherein a variable to be embodied is inserted between the graph nodes," (emphasis added) as recited in claim 1.

Claims 4-7 and 10-11 depend from claim 1. As explained, claim 1 recites elements not disclosed by Tateishi. Accordingly, claims 4-7 and 10-11 are allowable over Tateishi at least due to their dependence from claim 1. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Claims 15 and 16, although of different scope, recite elements similar to that discussed above with regard to claim 1. Applicants therefore request the Examiner to withdraw the rejection of claims 15-16 for at least the same reasons discussed above with respect to claim 1.

II.   The Rejection of Claim 3 Under 35 U.S.C. § 103(a).

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over <u>Tateishi</u> in view of <u>Bello et al</u>. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *See* M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. *See* M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claim 3 depends from claim 1. As noted above, <u>Tateishi</u> fails to disclose the claimed "structured document database" and "variable to be embodied that is inserted between the graph nodes," as recited in claim 1. <u>Bello et al.</u> is also silent as the claimed "structured document database" and "variable to be embodied that is inserted between the graph nodes," and the Examiner merely cited <u>Bello et al.</u> for allegedly teaching "selecting, from an applicable plan generation rules, a plan generation rule a cost of which is less than said applicable plan generation rules." OA at 5. Claim 3, therefore, is allowable over the Examiner's proposed combination of <u>Tateishi</u> and <u>Bello et al.</u> at least due to its dependence from claim 1.
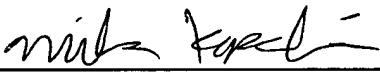
III. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 14, 2005   By: _____

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